REMARKS

1. Status of the Claims

Claims 23-29 and 32-33 as previously filed and claim 34 as currently amended are pending.

Claims 1-22, 30, and 31 have been canceled without prejudice to their assertion in a continuing application.

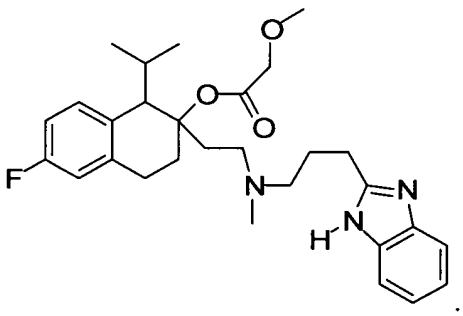
No new matter has been added.

2. Rejections Based on 35 U.S.C. § 112, First Paragraph

Claims 23-29, 32, 33, and 34 (in part) stand rejected as allegedly failing to comply with the enablement requirement of 35 U.S.C. § 112, First Paragraph. Applicants respectfully disagree.

Upon reviewing the Office's rejection, it is clear to the Applicants that the rejection is based on the following three factors: 1) no testing data is presented, 2) the compounds are not analogs of Mibefradil, and 3) the art is unpredictable.

The structure of Mibefradil is as follows:



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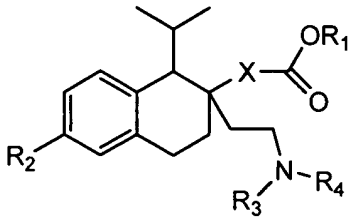
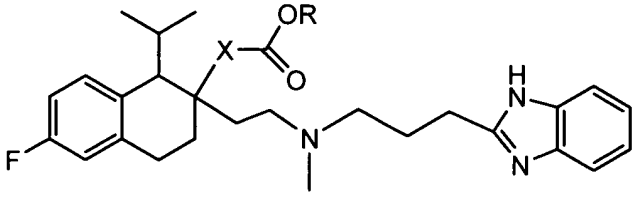
The structure from independent claim 23 is

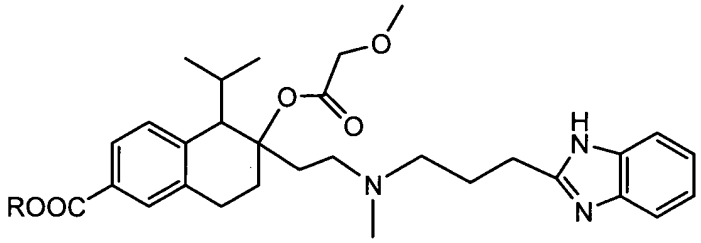


The structures from independent claim 24 are:

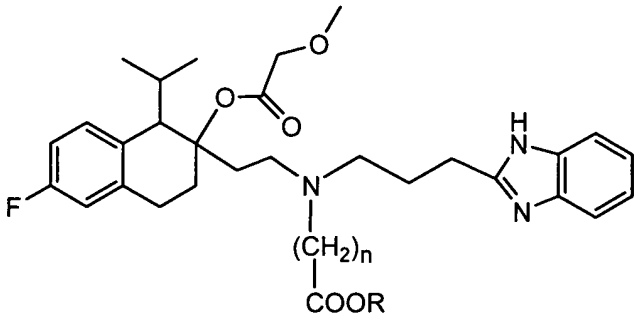


X=bond, CH_2, or OCH_2

R=lower alkyl optionally substituted OH or NH_2;

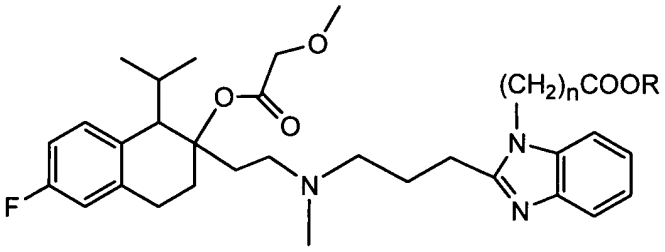


R=lower alkyl optionally substituted by OH or NH_2;



n=1 to 3

R=lower alkyl optionally substituted by OH or NH_2;



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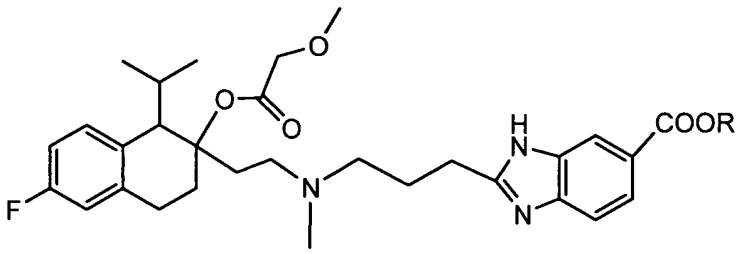
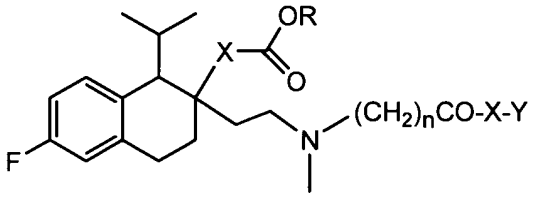
n=1 to 3

R=lower alkyl optionally substituted by OH or NH_2;

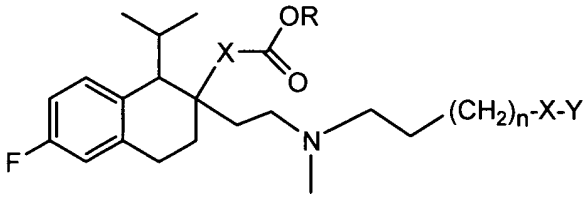


R=lower alkyl optionally substituted by OH or NH_2;

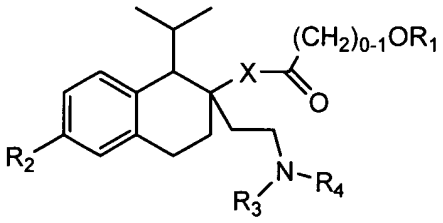


n=1 to 3 X=O, NH, NR where R is lower alkyl

Y=optionally substituted aryl or heterocyclyl; and



The structure from claim independent claim 34 is



Upon reviewing the structure of mibefradil (above) and the structures from the independent claims, it is clear that the claimed structures were not randomly picked, but are analogs of mibefradil. They have the same tetrahydrodecalin core with substitution at positions 1, 2, 2, and 6. Further, they all have the isopropyl group at position 1. The substitution at positions 2, 2, and 6 are also related to those of mibefradil, albeit, while being novel and non-

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obvious. As analogs of mibefradil, they are expected to have biological activities similar to those of mibefradil. Therefore, since mibefradil is a known calcium channel inhibitor, it stands to reason that the currently claimed compounds are calcium channel inhibitors. Therefore, we do not need to disclose specific experimental date for the currently claimed compounds.

Any unpredictability in the art is also accounted for by the similarity between the claimed compounds and mibefradile. As unpredictable as the art may be, one of skill in the art, looking at mibefradil and the currently claimed compounds would appreciate that all of the structures would have similar biological, i.e., calcium channel blocking, activity.

In fact, the Office, in the office action mailed February 8, 2005, stated that the specification was enabling for "calcium channel blocking compounds of structures shown in Figures 1-9 of the specification." Many of these same structures from Figures 1-9 are included in the currently pending independent claims. Since the claims cover structures that the Office has already recognized as being enabled, the claims must be enabled. As a result of the above, the claims are enabled and the Applicants request that the Office withdraw its enablement rejection based on 35 U.S.C. § 112, First Paragraph.

3. Rejections Based on 35 U.S.C. § 102(b)

Claim 34 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Branca et al. (U.S. Patent No. 4,808,605). As a preliminary matter, Applicants note that the Office appears to have mis-identified the variable R_3. In the office action, R_3 is defined as "lower-alkyl-carbonyl-oxy" but Applicants believe that it should be "lower-alkoxy-lower-alkylcarbonyloxy," (because the generic structure in claim 34 requires the presence of an "OR_1" group) and they have proceeded accordingly. If the Applicants are mistaken, they request clarification.

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In response to the rejection, the Applicants have inserted a proviso that excises the material cited by the Patent Office from the claims. As a result, Applicants submit that the above rejection based on 35 U.S.C. § 102(b) is moot, and they request that it be withdrawn.

CONCLUSION

Applicants respectfully contend that all requirements of patentability have been met. Allowance of the claims and passage of the case to issue are therefore respectfully solicited.

Should the Examiner believe a discussion of this matter would be helpful, he is invited to telephone the undersigned at (312) 913-2114.

Respectfully submitted,

Date: 10·3·05

By: Bradley W. Crawford
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